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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,087

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Mauro Sentinelli

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EXAMINER

ZIA, SYED

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,087	<b>Applicant(s)</b> SENTINELLI, MAURO	
	<b>Examiner</b> SYED ZIA	<b>Art Unit</b> 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This office action is in response to amendment filed on May 3, 2005. Applicant also submitted a preliminary amendments cancelling claims 1-32, and adding new claims 33-62. Claims 33-62 are pending.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 47 and 60-62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Claim 47 recite ac a computer program, which is interpreted as software per se, however, the claims fail to assert the program recorded on an appropriate computer-readable medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer without a computer-readable medium needed to realize the computer program's functionality, it is regarded as nonstatutory functional descriptive material. See MPEP 2106.01 for details.

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4. Claims 60-62 recite an authentication kit, which is interpreted as software per se, however, the claims fail to assert the program recorded on an appropriate computer-readable medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer without a computer-readable medium needed to realize the computer program's functionality, it is regarded as nonstatutory functional descriptive material. See MPEP 2106.01 for details.

5. Claims 60-62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 60-62 are not statutory because they are directed towards authentication kit comprising information stored in module(s) which could be implemented via software alone. Claims to software per se are not statutory. Applicant must recite some form of hardware as part of the claimed system to overcome this rejection.

### ***Claim Objections***

Claim 52 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Alie (U. S.

Publication No.: 2003/0055738).

1. Regarding Claim 33 Alie teaches and describes a method of authenticating a data processing terminal of a user for granting the data processing terminal access to selected services provided by a data processing system, the user being provided with an authenticatable mobile communication terminal adapted to be used in a mobile communication network, comprising: performing a first, SIM-based authentication of the user's data processing terminal in the data processing system at an authentication data processing server, said performing the SIM-based authentication comprising operatively associating with the user's data processing terminal a first subscriber identity module issued to the data processing terminal user; having the user's mobile communication terminal authenticated in the mobile communication network; and conditioning the authentication of the user's data processing terminal in the data processing system to a second authentication, said second authentication being based on identification information provided to the user at the mobile communication terminal through the mobile communication network ([0070-0096]).

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2. Regarding Claim 44 Alie teaches and describes a method by which a data processing terminal in a data processing system is authenticated in order to be granted access to selected services provided by the data processing system, the method comprising: interacting with a first user's subscriber identity module (SIM) operatively associated with the data processing terminal, and with an authentication data processing server in the data processing system, for performing a SIM-based authentication of the user's data processing terminal; acquiring personal identification information provided to the user at a user's mobile communication terminal authenticated through a mobile communication network; and sending said personal identification information to the authentication data processing server for completing the authentication of the data processing terminal ([0070-0096]).

3. Regarding Claim 48 Alie teaches and describes a method by which an authentication data processing server authenticates a user's data processing terminal in a data processing system in order to grant the data processing terminal access to selected services provided by the data processing system, comprising: receiving a request of authentication of the data processing terminal, the data processing terminal having operatively associated therewith a first subscriber identity module; performing a SIM-based authentication of the data processing terminal based on data associated with the first subscriber identity module; providing the user with first personal identification information by exploiting a user's mobile communication terminal authenticated in a mobile communication network; and conditioning the authentication of the user's data processing terminal to a prescribed correspondence between the first personal identification information provided to the user and second personal identification information received from

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the user's data processing terminal in reply to the provision of the first personal identification information ([0070-0096]).

4. Regarding Claim 53 Alie teaches and describes in a data processing system, a system for authenticating a data processing terminal of a user so as to grant the data processing terminal access to selected services provided by the data processing system, the user having an authenticatable mobile communication terminal adapted to be used in a mobile communication network, comprising: a first subscriber identity module operatively associatable with the data processing terminal; and an authentication data processing server adapted to carry out a first authentication step based on the first subscriber identity module; the authentication data processing server being further adapted to carry out a second authentication process based on identification information provided to the user at the mobile communication terminal through the mobile communication network ([0070-0096]).

5. Regarding Claim 60 Alie teaches and describes an authentication kit for authenticating a user's data processing terminal in a data processing system in order to grant the data processing terminal access to selected services provided by the data processing system, comprising: a first subscriber identity module; a computer peripheral device having associated therewith the first subscriber identity module and operatively associatable with the user's data processing terminal; and a second subscriber identity module operatively associated with a user's mobile communication terminal for allowing connection thereof to a mobile communication network ([0070-0096]).

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6. Regarding Claim 62 Alie teaches and describes an authentication kit for authenticating a user's data processing terminal in a data processing system in order to grant the data processing terminal access to selected services provided by the data processing system, comprising: a first subscriber identity module; a computer peripheral device having associated therewith the first subscriber identity module and operatively associatable with the user's data processing terminal; a second subscriber identity module operatively associated with a user's mobile communication terminal for allowing connection thereof to a mobile communication network; and the computer program product of claim 52 ([0070-0096]).

4. Claims 34-43, 45-47, 49-52, 54-59, , and 61 are rejected applied as above rejecting Claims 33, 44, 48, 53, and 60. Furthermore, Alie teaches and describes data dependent scrambler, wherein:

As per Claim 34, said second authentication comprises: generating a first password at the authentication data processing server; sending the first password to the mobile communication terminal over the mobile communication network; and checking a correspondence between the first password and a second password, depending on the first password, entered at the data processing terminal and provided to the authentication data processing server through the data processing system ([0058-0068]).

As per Claim 35, comprising having the user entering the second password through the data processing terminal ([0010-0018]).



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As per Claim 36, the second password is entered automatically upon receipt of the first password at the user's mobile communication terminal ([0070-0076]).

As per Claim 37, said first password is usable a limited number of times, or one time only ([0070-0076]).

As per Claim 38, comprising issuing to the user a second subscriber identity module adapted to be used in the user's mobile communication terminal for authentication thereof in the mobile communication network ([0010-0018]).

As per Claim 39, the second subscriber identity module has a fixed, one-to-one relationship with the first subscriber identity module ([0070-0076]).

As per Claim 40, the first subscriber identity module is associated with an identifier of the second subscriber identity module, or a mobile communication terminal number ([0070-0096]).

As per Claim 41, said identification information is sent to the user's mobile communication terminal by way of a short message service message ([0070-0096]).

As per Claim 42, said first subscriber identity module is of a type adopted in mobile communication networks for authenticating mobile communication terminals ([0010-0018]).

As per Claim 43, said performing the first, SIM-based authentication of the data processing terminal comprises having the first subscriber identity module authenticated by an authentication server of the data processing system, the authentication server acting substantially as an authentication center of a mobile communication network operator ([0070-0096]).

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As per Claim 45, in which the first subscriber identity module is of a type adopted in mobile communication networks for authenticating mobile communication terminals ([0010-0018]).

As per Claim 46, further comprising: retrieving SIM identification data from the first subscriber identity module ;communicating the retrieved SIM identification data to the authentication server, the authentication server acting substantially as an authentication center of a mobile communication network operator; receiving from the authentication server SIM authentication data corresponding to the SIM identification data, and passing the SIM identification data to the first subscriber identity module; and communicating to the authentication server a response generated by the first subscriber identity module ([0070-0096]).

As per Claim 47, a computer program directly loadable into a working memory of a data processing terminal capable of performing, when executed, the method according to claim 44 ([0054-0068]).

As per Claim 49, the first subscriber identity module is of a type adopted in mobile communication networks for authenticating mobile communication terminals, the authentication data processing server acting substantially as an authentication center of a mobile communication network operator ([0054-0068]).

As per Claim 50, further comprising: generating at the authentication data processing server a first password and sending the first password over the mobile communication network to the user's mobile communication terminal; and conditioning the authentication of the data processing terminal in the data processing system to a prescribed correspondence between the first password and a second password, depending on the first password, entered at the data

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processing terminal and provided to the authentication data processing server through the data processing system ([0058-0068]).

As per Claim 51, a computer program directly loadable into a working memory of an authentication data processing system capable of performing, when executed, the method according to claim 48 ([0054-0068]).

As per Claim 54, the first subscriber identity module is of a type adopted in mobile communication networks for authenticating mobile communication terminals ([0010-0018]).

As per Claim 55, comprising a second subscriber identity module to be used in the mobile communication terminal for authenticating the mobile communication terminal in a mobile communication network ([0010-0018]).

As per Claim 56, the second subscriber identity module is in a fixed, one-to-one relationship with the first subscriber identity module ([0070-0076]).

As per Claim 57, the second subscriber identity module is associated with an identifier of the second subscriber identity module, particularly a mobile communication terminal number ([0070-0076]).

As per Claim 58, said first subscriber identity module is associated with a device connectable to the computer through a computer peripheral connection port ([0010-0018]).

As per Claim 59, said mobile communication network is one among a GSM, a GPRS, and a UMTS network ([0070-0096]).

As per Claim 61, the first subscriber identity module is of a type adopted in mobile communication networks for authenticating mobile communication terminals ([0010-0018]).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED ZIA whose telephone number is (571)272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SZ

July 16, 2009

/Syed Zia/

Primary Examiner, Art Unit 2431

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